

## REMARKS

Claims 1-7, 9-41 and 57-60 are presently pending in the application and stand rejected. Claims 1-7, 9-14, 20, 21, 26-41 and 57-59 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,653,706 to Zavislan et al. Claims 15-19 and 22-25 are rejected under 35 U.S.C. 103(a) over Zavislan in view of US 5,437,290 to Bolger et al. In the present amendment claims 1 and 57 are amended and claim 9 is cancelled.

Claim 1 is amended to include the limitation recited in cancelled claim 9 that the imaging subsystem operates automatically. The amendment makes more explicit what is already explicit in the claim that, as noted in applicant's preceding amendment, it is the imaging subsystem that autonomously determines *whether or not a region of the skin has a feature to be treated and if so a location of the feature*. Applicant further reiterates, in traverse of the Examiner's opinion in the preceding office action, that Zavislan does not describe such an automatic imaging system.

The Examiner supports his contention that Zavislan does in fact describe such an automatic system by citing column 4 lines 28-38. Applicant submits that the cited text does not teach an optical subsystem that automatically determines the presence of a feature needing treatment nor its location and in fact teaches away from such a system by teaching a manually operated system.

The word "automatically" is indeed present in the cited section, but is descriptive of the ability of Zavislan's system *to focus automatically not of its ability to decide if a treatment-needing feature is present, nor of an ability to determine location of such a feature*. The cited section explicitly notes that the system is steered by "a beam steering device 28 which may be a joystick trackball or computer mouse type device" and that the "controller 24 obtains signals from the beam steering device 28 and applies them to a beam deflection system ... which step or steer the beam in the X and Y directions". The controller "applies signals ... to steer the beam in the X and Y to the desired locations"; and then, "Automatically, these locations are focused in the visualization plane and an image is provided by the camera".

All the examples of a beam steering device noted by Zavislan are manually operated devices and the signals applied by the controller to steer the beam to the "desired locations" are clearly responsive to the signals from the beam steering device. Zavislan's system clearly has no autonomous ability to determine the presence or location of a treatment-needing feature. Only after Zavislan's invention is steered to a location of such a feature by a human operating the beam steering device does any automatic function operate, namely the function of focusing the location

in the visualization plane.

The Examiner has also noted in the preceding office action that even were claim 1 to recite "automatically locates" the claim would not be patentable since "the process of automating the imaging subsystem is not patentable subject matter". Applicant respectfully traverses.


The Statute does not preclude patentability of "automating", and such a disposition would clearly be incompatible with the intention of Congress and the Supreme Court's construction of Section 101 that statutory subject matter "include anything under the sun that is made by man." (see *Diamond v. Chakrabarty*, 447 U.S. 303, 309). In spite of MPEP 2144.04 (III), in re *Venner* 262 F.2d 91, 95 120 USPQ 193, 194, (CCPA1958), cannot be interpreted as a general negation of the patentability of devices or methods that automate human activity. A cursory search of the US patent will provide a plethora of patents explicitly claiming inventions to automatic devices that replace human labor or decision-making functions.

Claim 57 is similarly amended to include the word automatically to make explicit the decision-making autonomy of the imaging subsystem.

As to claim 3, the Examiner states that Zavislan uses "a single laser source ... operable to varying in wavelength over a given range". Applicant has not been able to locate in Zavislan any mention that the laser provides a varying wavelength. In fact, Zavislan notes that it is an object of the invention to provide "a single instrument using a single wavelength laser beam for different microsurgical and dermatological treatments" (column 2 lines 43-45). Zavislan therefore does not anticipate claim 3 and must be understood to teach away from a tunable laser beam.

In view of the above, applicant submits that independent claims 1 and 57, are not anticipated by Zavislan and that all the claims in the present claim set are patentable, either through dependence on claims 1 or 57 or as a result of patentable material that they contain. An action on the merits is respectfully awaited.

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September 27, 2004

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